

Fay (U.S. Pat. No. 5,983,201); claims 1-2, 4-5, 8-12 and 67 stand rejected under Section 103(a) as being unpatentable over *Fay*; claims 6 and 7 stand rejected under Section 103(a) as being unpatentable over *Fay* and further in view of *Maloomian* (U.S. Pat. No. 4,261,012); claims 82 and 83 stand rejected under Section 103(a) as being unpatentable over *Fay* and further in view of *Brush, II et al.* (U.S. Pat. No. 5,884,029); claims 13-16, 19-24 and 68 stand rejected under Section 103(a) as being unpatentable over *Fay*; claims 17 and 18 stand rejected under Section 103(a) as being unpatentable over *Fay* and further in view of *Maloomian*; claims 25-26, 28-34 and 69 stand rejected under Section 103(a) as being unpatentable over *Fay* in view of *Hill* (U.S. Pat. No. 5,970,471); claim 27 stands rejected under Section 103(a) as being unpatentable over *Fay* and further in view of *Hill*; claim 35 stands rejected under Section 103(a) as being unpatentable over *Fay* and *Hill* and further in view of the *Brown* article "Macy's eases Swimsuit Fear with Database;" claims 36-42, 43-50, 70 and 71 stand rejected under Section 103(a) as being unpatentable over *Fay*; claims 51-58, 59-66 and 72 stand rejected under Section 103(a) as being unpatentable over *Fay* in view of *Hill*; claims 73-76, 77, 79 and 80 stand rejected under Section 103(a) as being unpatentable over *Fay*; and claim 81 stands rejected under Section 103(a) as being unpatentable over *Fay* and further in view of the *Brown* article "Macy's eases Swimsuit Fear with Database." Applicant appreciates the indication of the allowability of claim 3 if rewritten in independent form.

Applicant has amended claim 3 to include all of the limitations of the base claim and any intervening claims and thus submits that amended claim 3 is allowable.

With respect to the drawings, the specification has been amended to properly include all reference numbers included in the figures.

Claims 19, 36, 39 and 43 have been amended in accordance to the Examiner's instructions; therefore, Applicant requests that the objection be removed.

With respect to the Section 112 rejection, claims 43, 77 and 80 have been amended to include proper antecedent basis as requested by the Examiner. Applicant requests that the rejection be withdrawn.

Claims 1, 13, 25, 51, 59 and 73 have been amended to further clarify the instant invention.

Claim 78 has been canceled and the Section 103(a) rejection thereof is therefore moot.

Applicant respectfully traverses the Section 103(a) rejections, all of which rely upon the '201 reference as a primary reference, because no *prima facie* case of obviousness has been presented. In order to establish a *prima facie* Section 103(a) rejection, the cited reference or references must teach or suggest every element of the claimed invention and there must be motivation in the prior art for modifying the cited reference(s) to arrive at the claimed invention. For instance, recent case law indicates that evidence of motivation must be specifically identified and shown by some objective teaching in the prior art leading to the modification. "Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to references relating to possible solutions to that problem.'" Ruiz v. A.B. Chance Co., (Fed. Cir., December 6, 2000).

In the present application, the Office Action failed to present motivation in support of the modification of the cited '201 reference. Evidence has not been provided of any prior art motivation for modifying the '201 reference in connection with a plurality of the claim rejections, some of which are discussed below. For example, regarding various ones of the claims including independent claims 1, 13, 36, 43, 51, 73, 77 and 80 the Office Action failed to provide evidence of motivation for modifying the computer at the second location (or other location) of the '201 reference to be a server computer, as acknowledged on page 7 of the Office Action as not being taught by the '201 reference. In regard to claim 9, the Office Action acknowledges that the '201 reference does not disclose selecting a third image of a background setting prior to generating data of a composite image, and no evidence of motivation has been cited for modifying the '201 reference to include such limitations. In regard to claims 6 and 7, as acknowledged on page 9 of the Office Action, the '201 reference does not disclose manipulating data of the first image to modify a size of the first image to correspond to a template having a predetermined size. The Office Action has not cited any evidence of motivation in the

prior art for modifying the '201 reference to include such a template and/or for using such a template to modify the size of the first image or generating data of a composite image. Regarding claim 82, no evidence of motivation for modifying the '201 reference to include displaying a three-dimensional image has been provided. Regarding claim 83, no evidence of motivation for modifying the '201 reference to include a holographic display apparatus or a virtual reality apparatus has been provided. Regarding claim 20, no evidence of motivation has been cited for displaying the modified image on a web page. Regarding claim 25, as indicated on page 15 of the Office Action, the '201 reference does not disclose generating a second composite image from a second image of the person as well as a second accessory image. The Office Action has not cited any evidence of motivation in the prior art for modifying the '201 reference to include such second composite image generation. Regarding claim 59, the '201 reference fails to disclose subject matter including displaying first and second composite images, and fails to provide evidence of motivation for modifying the '201 reference to include this subject matter. Various ones of the rejections of the dependent claims similarly lack motivation. In view of the above, the Office Action fails to indicate reasons why one skilled in the art would be motivated to modify the '201 reference, and does not provide any evidence of factual teachings, suggestions or incentives from the prior art that lead to the proposed modification. Therefore, Applicant requests that the Section 103(a) rejections be withdrawn.

Applicant further submits that the cited portions of the references fail to teach or suggest every claimed limitation of the present invention. For instance, regarding amended claims 1, 3, 13, 36, 43, 73, 77 and 80, the cited portion of the '201 reference fails to teach, for example, "the server computer being linked to different accessory-provider computer sites respectively having different accessories for viewing."

Moreover, Applicant submits that the Office Action failed to cite teaching or suggestion of various other claimed limitations to which "Official Notice" has been taken (e.g., limitations of independent claims 1, 20, 25 and 51, and dependent claim 9) because no accompanying documentation in support thereof has been provided. M.P.E.P. §2144.03 requires that such notice must be supported by accompanying documentation, which is absent in this instance. Should the rejection(s) be maintained, Applicant

requests documentation in support of the multiple "Official Notices" and the opportunity to evaluate the propriety of any alleged combinability of any such documentation with the asserted embodiments of *Fay*.

In view of the above, Applicant submits that the Office Action failed to cite portions of a reference or references that teach or suggest all of the claimed limitations of the present invention and also failed to provide any evidence of motivation for modifying the primary '201 reference. Therefore, the Office Action failed to establish a *prima facie* case of obviousness, and Applicant requests that the Section 103(a) rejections, which all rely upon the primary '201 reference, be removed.

Please charge Deposit Account No. 50-0996 (JARB.007PA) in the amount of \$84.00 for the additional independent claim and charge/credit the same Deposit Account for any deficiency/surplus, if necessary.

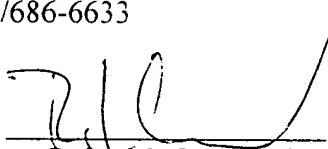
In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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Markup

APPENDIX A - CLAIM CHANGES FOR S/N 09/307,261

1. (Amended) A method for previewing an accessory to be worn by a person, the method comprising :

providing a first image to an input device at a first location, the first image including at least a portion of [a] the person;

transmitting data of the first image to a server computer at a second location, the server computer being linked to different accessory-provider computer sites respectively having different accessories for viewing;

selecting a second image from an electronic database of images on or accessible to the server computer, the second image comprising an image of [an accessory] one of the accessories to be worn on the portion of the person in the first image;

generating data of a composite image from the data of the first image and data of the second image with the server computer, the composite image including the accessory worn on the portion of the person; and

displaying the composite image on an output device at the first location

3. (Amended) [The method of claim 1 wherein the accessory is a pair of sunglasses, and wherein the method further comprises] A method for previewing a pair of sunglasses to be worn by a person, the method comprising :

providing a first image to an input device at a first location, the first image including at least a face portion of the person;

transmitting data of the first image to a server computer at a second location;

selecting a second image from an electronic database of images on or accessible to the server computer, the second image comprising an image of a pair of sunglasses to be worn on the portion of the person in the first image;

generating data of a composite image from the data of the first image and data of the second image with the server computer, the composite image including the pair of sunglasses worn on the portion of the person;

displaying the composite image on an output device at the first location; and

displaying a shaded image, wherein a shade of the shaded image corresponds to a shade seen by a person wearing the pair of sunglasses.

13. (Amended) A method for previewing an accessory, the method comprising:

providing data of a first image of at least a portion of an intended recipient of the accessory to a server computer, the server computer being linked to different accessory-provider computer sites respectively having different accessories for viewing;

selecting a second image from an electronic database of images, the second image comprising an image of [an accessory] one of the accessories to be worn on the portion of the intended recipient in the first image;

generating data of a composite image illustrating the accessory being worn on said portion from the data of the first image and data of the second image with the server computer;

transmitting the data of the composite image from the server computer to a client computer; and

displaying the composite image on an output device in communication with the client computer.

19. (Amended) The method of claim 13 wherein transmitting the data of the composite image from the server computer to the client computer comprises transmitting the data of the composite image from the server computer to the client computer via the Internet.

25. (Amended) A method for previewing an accessory, the method comprising:

generating a first composite image from a first image of a person and a first accessory image;

displaying the first composite image to a customer;

saving the first composite image;

generating a second composite image from a second image of the person and a second accessory image;

displaying the first and second composite images simultaneously to the customer such that the customer can evaluate the appearance of the first and second accessories on

the person, at least one of the composite images showing one of the accessories being worn on the person.

36. (Amended) A system for previewing an accessory, the system comprising:

an input device for receiving a first image, wherein the first image includes an image of at least a portion of a person;

a client computer operatively coupled to the input device;

a server computer including a first computer program for selecting data of a second image from an electronic database of images, the server computer being linked to different accessory-provider computer sites respectively having different accessories for viewing, the second image comprising an image of [an accessory] one of the accessories to be worn on the portion of the person in the first image, and a second computer program for generating data of a composite image illustrating the accessory being worn on said portion of a person from data of the first image and data of the second image, wherein the server computer is operatively coupled to the client computer; and

an output device for displaying the composite image, wherein the output device is operatively coupled to the client computer,

wherein the input device, client computer, and the output device are at a first location and wherein the server computer is located at a second location.

39. (Amended) The system of claim 36 further comprising an Internet service provider intermediate between the client computer and the server computer.

43. (Amended) A system for previewing an accessory, the system comprising:

an information storage medium comprising a first electronic database of images of people;

a server computer, the server computer being linked to different accessory-provider computer sites respectively having different accessories for viewing, and the server computer including (i) a first computer program for selecting a first image from the first electronic database, the first image comprising an image of an intended recipient of an accessory, (ii) a second computer program for selecting a second image from a

second electronic database, the second image comprising an image of [an accessory] one of the accessories to be worn on the intended recipient in the first image, and (iii) a third computer program for generating data of a composite image illustrating the accessory being worn on the intended recipient from the data of the first image and data of the second image[, wherein the server computer is operatively coupled to the client computer];

a client computer for receiving the data of the composite image, wherein the client computer is operatively coupled to the server computer; and

an output device for displaying the composite image, wherein the output device is operatively coupled to the client computer.

51. (Amended) A system for previewing an accessory before purchasing the accessory, the system comprising:

a server computer comprising (i) a first computer program for selecting data of a first accessory image from an electronic database, (ii) a second computer program for generating data of a first composite image from data of the first accessory image and data of a person's image, (iii) a third computer program for selecting data of a second accessory image from the electronic database, and (iv) a fourth computer program for generating data of a second composite image from data of the second accessory image and data of the person's image;

an information storage medium for saving data of the first composite image, the information storage medium being on or accessible to the server computer;

a client computer operatively coupled with the server computer; and

a display device for displaying the first and second composite images to a customer for simultaneously previewing accessories before purchasing, at least one of the composite images showing one of the accessories being worn on the person.

59. (Amended) An electronic display screen for assisting a customer to select a desired accessory, the screen comprising:

a previously saved first composite image generated from an image of a person and an image of a first accessory; and

a second composite image generated from an image of the person and an image of a second and different accessory, at least one of the composite images showing one of the accessories being worn on the person

[wherein the first and second accessories are different].

73. (Amended) A method for permitting a customer to preview a pair of sunglasses before purchasing, the method comprising:

providing a first image to an input device operatively coupled to a client computer, the first image including the face of a person;

transforming the first image into data of the first image with the client computer;

transmitting data of the first image from the client computer to a server computer via the Internet, the server computer being linked to different accessory-provider computer sites respectively having different accessories for viewing;

selecting a second image from an electronic database of images on or accessible to the server computer, the second image comprising an image of a pair of sunglasses;

generating data of a composite image from the data of the first image and data of the second image with the server computer, the composite image including the image of the pair of sunglasses on the face of the person;

transmitting the data of the composite image from the server computer to the client computer via the Internet; and

displaying the composite image on a display device operatively coupled to the client computer such that a customer can preview the sunglasses before purchasing,

wherein the input device, the output device and the client computer are at a first location, and wherein the server computer is at a second location.

77. (Amended) A method for permitting a customer to preview a pair of sunglasses before purchasing, the method comprising:

providing a first image to an input device operatively coupled to a client computer, the first image including the face of a person;

transforming the first image into data of the first image with the client computer;

transmitting data of the first image from the client computer to a server computer via the Internet;

selecting a second image from an electronic database of images on or accessible to the server computer, the second image comprising an image of a pair of sunglasses;

generating data of a composite image from the data of the first image and data of the second image with the server computer, the composite image including the image of the pair of sunglasses on the face of the person;

transmitting the data of the composite image from the server computer to the client computer via the Internet, the server computer being linked to different accessory-provider computer sites respectively having different accessories for viewing; and

displaying the composite image on a display device operatively coupled to the client computer such that a customer can preview the [accessory] second image before purchasing,

wherein the client computer, the input device and the output device are at a kiosk.

80. (Amended) A method for previewing an accessory at a client computer, the method comprising:

providing data of a first image of at least a portion of a person to a server computer, the server computer being linked to different accessory-provider computer sites respectively having different accessories for viewing;

selecting a second image from an electronic database of images, the second image comprising an image of [an accessory] one of the accessories to be worn on the portion of the person in the first image, wherein the accessory is at least one of sunglasses, jewelry, handbags, and cosmetics;

generating data of a composite image from the data of the first image and data of the second image with the server computer, the composite image comprising the accessory on the person; and

displaying the composite image on an output device in communication with the client computer.

APPENDIX B – SPECIFICATION CHANGES

At page 24, lines 4-16:

After the customer contacts the seller's Web site, the customer can browse the electronic accessory catalog on the seller's Web site. For example, FIG.4 shows a display screen on a Web page. The Web page has plural images of sunglasses 211. Each sunglass image can represent a different collection of sunglasses. The customer viewing the display screen shown in FIG. 4 can select one or more of the sunglass images to display plural sunglass images having the same style, type, or size as the selected sunglass image. In this regard, each of the sunglass images can be a hyperlink to other Web pages having more sunglass images of the same style, type, or size as the selected sunglass image. Alternatively, the sunglass images shown in FIG. 4 can be selected for previewing on the intended recipient. The customer can also browse through the men's or women's sunglass images for sale by the seller. For example, the customer can select the hyperlink "Men's Styles" 212 or the hyperlink "Ladies' Styles" 213 to request one or more Web pages respectively showing or highlighting men's['] or women's sunglass styles for browsing or viewing by the customer.

At page 33 line 12 – page 34 line 2:

While the provided image of the intended recipient can be adjusted automatically to correspond to the template, the provided image of the intended recipient may also be manually adjusted to the size of the intended recipient's image. For example, FIG. 13 shows a template 261 having crosses 262 which can correspond to the pupils on the face of an intended recipient in a provided image. The image of the intended recipient's face can be reduced or enlarged by scaling the image, e.g., with first and second scaling elements 265, 266 on the Web page. The position of the provided image may also be changed with two or more position elements 263, 264 displayed on the Web page. A "help" button 267 can also be provided on the display to help the customer with the purchasing or previewing process. If correspondence between the template and the modified image is not achieved, then other templates can be presented to and selected by the customer for comparison by selecting the appropriate button 268 on the display

screen. After correspondence between the modified image and the template is achieved, suitable sunglasses can be selected for the customer to browse and suitable composite images can be generated.

At page 37, lines 5-17:

One illustration of how favorable composite images can be saved and then represented can be described with reference to FIGS. 15 and 16. For example, after a customer decides that the accessory shown in a composite image shown in FIG. 15 is favorable, a button 272 can be selected to add the previewed image or accessory to a “favorites” list. The favorites list may include one or more composite images which the customer has determined are favorable, and can be re-presented to the customer for re-evaluation and comparison with other composite images. To view the favorites list, the “favorite” hyperlink 283 can be selected and one or more display screens having composite images displaying favorable accessories can be viewed and compared with other composite images. More specifically, the customer can compare, in a side-by-side or sequential manner, a variety of favorable composite images to determine which accessories are the most desirable. A “more” button 285 can be selected by the customer to display additional favorable composite images, favorite screens, or accessory images. This process can be repeated as many times as desired (e.g., two or more times) to find desirable accessories to purchase.

At page 26, lines 13-21:

The image of the intended recipient can be provided to the system in any suitable manner. For example, the display screen shown in FIG. 6 provides three options for the customer. If the customer is at a kiosk, the customer can provide the image of the intended recipient to an input device at the kiosk 241 so that data of the image can be transmitted to the server computer. The customer may also e-mail 242 or mail 243 the image of the intended recipient to the seller so that the seller can provide the image to the system and then to the server computer. If the customer has already completed one or more of these tasks, the “I’ve done that” button [244] 245 can be selected to inform the

seller that the task has been completed. The customer may also request more information about the image providing process by selecting the “more info” button [245] 244.